

## **REMARKS AND ARGUMENTS**

### **The Status of the Claims.**

Claims 1 and 17 to 20 are pending with entry of this amendment. Claim 2 is cancelled herein, and claims 3 to 16 and 21 to 26 were previously cancelled. Claims 1 and 17 are amended herein. These amendments introduce no new matter and support is replete throughout the specification. These amendments are made without prejudice and are not to be construed as abandonment of the previously claimed subject matter or agreement with any objection or rejection of record.

With respect to claims 1 and 17, support for a double bond between the lactam and fluorescent moiety can be found throughout the specification. For example, see Figures 1, 2, 3, 4, 5 and 6, the specification in paragraph 50, and Table 1.

Applicants submit that no new matter has been added to the application by way of the above Amendment. The present amendments place the claims in condition for allowance. Accordingly, entry of the Amendment is respectfully requested.

### **35 U.S.C. §112, First Paragraph.**

Claims 19 and 20 were rejected under 35 U.S.C. §112, first paragraph. To be an enabling disclosure under § 112, first paragraph, a patent must contain a description that enables one skilled in the art to make and use the claimed invention.

The rejections in the Action are based on the assertion that the structures of claims 19 and 20 allegedly "do not fall within the ambit of Formula I, to which utility is tied." Applicants note that the structures of claims 19 and 20 do fall within the bounds of Formula I. However, in the interest of cooperation and to expedite prosecution of this application, claim 1 has been amended to further clarify the nature of the claimed structures.

Although the Examiner agrees that single bonded linkers are enabled by the specification, the Action suggests, e.g., that the general structure of Formula I does not include structures with a double bonded link between a lactam substrate and a fluorophore. This argument overlooks the teachings of the specification and fails to broadly construe the

terms, as required. However, this issue is now moot because the present claims have been amended, with nomenclature helpfully suggested by the Examiner, to claim structures of the invention, e.g., having either single bonds or double bonds linking the lactam substrate and fluorophore.

Support for the claims, as amended, is replete throughout the present specification. The present action admits extensive support for the single bond linkage embodiments of the invention (for example, see Figures 7 and 8, and associated text). Support for double bond linkage embodiments is present in the specification, e.g., in figures 1 to 6 and associated text.

The rejection of claims 19 and 20 were based solely on issues around the bond structure of Formula I. Because the structure has been further clarified in the currently amended claims, the rejection must be withdrawn.

### Utility

The Action had expressed arguments alleging a failure to tie the utility of the claim 1 compounds to the claim 19 and 20 compounds. At pages 2 and 3 of the Action, arguments are made that the claims are not enabled allegedly because utility of one species is not "linked" to that of another. Applicants note that "linkage" of utility is not a requirement. The issue is simply whether the claims have utility, which they clearly do.

Indeed, Applicants note that all the structures and claims of the invention do in fact have utility. Such utility is not only conceptual, but is shown by actual working examples of the compositions in use. The Action specifically finds utility in the claim 19 species wherein "A" is "S", e.g., in enzymatic fragmentation. Applicants note that the additional species of claim 19, wherein the "S" is singly or doubly oxidized are described in the specification as having additional utility related to, e.g., the use of the structures as lactamase enzyme substrates. For example, in Figures 4 and 5, and accompanying text, the oxidized forms of the structure are shown to be more stable, and thus useful in reagent stability important to analytical techniques. In Figure 6, a structure having S-O (n=1) is shown to be useful in detecting lactamases in vivo. It is unreasonable to suggest no utility is seen for any of the alternate claim 19 and claim 20 structures.

Applicants note that, although working examples are not required to support a claim, the present specification provides multiple actual and conceptual working examples of the claimed compositions. According to MPEP 2164, the claims are more than adequately supported with examples.

Again, because the claims are clearly supported by the specification with descriptions of how to make and use the claimed compounds, which plainly have utility, Applicants respectfully request withdrawal of all section 112 rejections.

### **Objections to the Claims**

Claims were objected to as allegedly not being further limiting over the independent claim 1. However, essentially as suggested by the Examiner, Applicants have amended the claims to more clearly place them in proper dependent form. That is, claim 1 has been amended, e.g., to further clarify the fact that structures of claims 19 and 20 are species of the compounds of claim 1.

Because claims 19 and 20 are species of claim 1, Applicants request that the objections be withdrawn.

### **CONCLUSION**

Applicants appreciate that claims 1, 2, 17 and 18, have previously been found allowable. The present amendments clarify, but certainly do not add subject matter to the previously considered allowable claims. Therefore, no new search or examination should be required to enter the present claims and find them allowable.

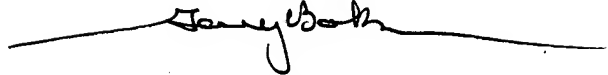
In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. Therefore, Applicants respectfully request entry of the present amendments. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the claims are deemed not to be in condition for allowance after consideration of this Response, a telephone interview with the Examiner is hereby requested. Please telephone the undersigned at (510) 769-3510 to schedule an interview.

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Respectfully submitted,



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Attachments:

- 1) A petition to extend the period of response for 2 months;
- 2) A transmittal sheet;
- 3) A notice of appeal;
- 4) A fee transmittal sheet; and,
- 5) A receipt indication postcard.